

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KUNIO WATANABE AND SHOZO TAKEYA

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Appeal No. 97-4239  
Application No. 08/387,158

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**ON BRIEF**

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Before Garris, Warren and Lieberman, Administrative Patent Judges.

Lieberman, Administrative Patent Judge.

**REMAND TO THE EXAMINER**

On consideration of the record, we find that this case is not ready for appeal and thus, we remand the application to the examiner for appropriate action.

The examiner has rejected the appealed claims as follows:

Claims 19 through 24, 26 through 28 and 30 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over ES 487646 in view of JP 04-157128, or JP02-149637 and further in view of Apostolos and prior art admission in page 2, lines 1-

2 of the specification.

### **OPINION**

The rejection before us is directed to a rejection predicated on a primary reference and either of two secondary references in combination with two other references. Both the primary reference and the two secondary references are cited and relied upon only as abstracts. Yet based upon these abstracts the examiner assumes that certain facts are omitted from the references. The examiner in one instance assumes that the “respective abstracts disclose the claimed aluminum sacrificial anode composition except for the application of aluminum anode alloy with a reinforced concrete construction.” Answer, page 4. Appellants, similarly state that, “it can be surmised that JP ‘637 also relates to cathodic protection in seawater.” See Brief, page 7. Neither assumption is based upon fact.

With respect to this rejection, the examiner has relied upon three abstracts in rejecting each of the claims rather than the underlying foreign patents or published patent applications themselves without apparently obtaining copies thereof. In this case, citation of an abstract without citation and reliance on the underlying foreign patent itself is unacceptable. Generally, abstracts may not be written by the author of the underlying document and often are erroneous. Hence, the preferred practice would be for the examiner to cite and rely on the underlying foreign patent publications. Therefore, based

on the paucity of factual data before us we are unable to make the requisite findings required for a determination as to whether the combination of references is appropriate and proper.

Accordingly, on consideration of the record we remand the application to the jurisdiction of the examiner for appropriate action in accordance with our comments *supra*.

Upon return of this application to the examiner, the examiner and applicants should reconsider the patentability of the claimed subject matter over the underlying foreign patents or published patent applications and translations thereof, including any possible combination of references.

This application, by virtue of its "special status", requires an immediate action, MPEP § 708.01 (7th ed., Rev. 1, February 2000). It is important that the board be promptly informed of any action affecting the appeal in this case.

REMANDED

BRADLEY R. GARRIS  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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